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In re application of: Tucholski :  
Serial No.: 07/641,394 :  
Filed: January 15, 1991 : PETITION FOR ACCESS  
For: BATTERIES WITH TESTER LABEL :

In response to the letter of August 23, 1993 (Paper No. 19), applicant filed an Objection to Petition for Access (Paper No. 21), and petitioner filed a Response to Objection for Access (Paper No. 22).

Applicant asserts in his Objection that petitioner is only entitled to access to the instant application as filed (copy served on petitioner), because, in essence, the claims of Patent No. 5,223,003 all include the step of applying a contrasting color layer (step (c) of claim 1), which step was not and could not have been claimed in this application because it is not disclosed therein. Petitioner, on the other hand, asserts that the step in question was already known in the art, and that therefore "allowance [of the patent] necessarily was based upon considerations which can only be understood from the analysis of the prosecution of the parent application." Also, petitioner contends that he should be entitled to access to the prosecution in this application of the remainder of the subject matter recited in the claims of the '003 patent.

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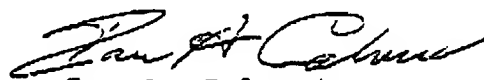
The claims of the '003 patent are drawn to a "process for preparing a label comprising a tester for a battery and for attaching it to a battery," while on the other hand all of the application claims are drawn to apparatus, i.e., to a battery or to a label, except for claim 45, which recites a process for attaching a label to a battery. The examiner required restriction between claims 1 to 44 and claim 45, finding that they were drawn to distinct inventions.

Accordingly, it is not considered that the apparatus claims in the application constitute subject matter claimed in the patent within the meaning of MPEP § 103. The petition is granted only to the extent that petitioner is granted access to the prosecution relating to process claim 45 of the application, viz., (1) the examiner's restriction requirement (Paper No. 4, 01/09/92); (2) applicant's response thereto (Paper No. 5); (3) the portions of the next Office action (Paper No. 6, 03/27/92) making the restriction requirement final, which are the first page, the first two paragraphs on page 2, and the last paragraph on page 3; and (4) parts of the amendment filed October 2, 1992 (Paper No. 7), consisting of page 4, the paragraph canceling claims 43-45, and page 5, the first paragraph under "Remarks."

The petition is granted to the extent indicated. However, the access granted herein will be withheld for a period

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of twenty days from the date of this letter to provide applicant with an opportunity to take such action as he may deem appropriate if he disagrees with this decision. If no such action is taken, a copy of the papers as indicated in the preceding paragraph will be mailed to petitioner at the end of the twenty-day period.



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Patent Judge

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IAC/dls